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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,414	11/09/2001	Rick Korczak	7836/83306	2098

7590 06/23/2004

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EXAMINER
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MARSH, STEVEN M

ART UNIT	PAPER NUMBER
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3632

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/046,414

Applicant(s)

KORCZAK ET AL.

Examiner

Steven M Marsh

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,8-13,24-26,29-32,37,39,40,49,73-75,78,82,142 and 143 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-13,24-26,29-32,37,39,40,49,73-75,78,82,142 and 143 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

This is the third office action for U.S. Application 10/046,414 for an Anchor Rail Adapter and Hanger Method filed by Korezak et al. on November 9, 2001. Claims 7, 14-23, 27, 28, 33-36, 38, 41-48, 50-72, 76, 77, 79-81, 83-141 have been canceled. Claims 142 and 143 have been added.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 15, 2004 has been entered.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: The 3<sup>rd</sup> line from the bottom of page 2 of the claims, the word "another" should be deleted and replaced with - - other - -. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 143 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 143 recites the limitation "said support legs" in line 2. There is insufficient antecedent basis for this limitation in the claim. Also, claim 143 is dependent upon canceled claim 76. It is not clear what legs Applicant is referring to, and therefore claim 143 has not been examined on its merits.

***Claim Rejections - 35 USC § 102***

Claims 1-4, 8, 9, 24-26, 29, 37, 39, 40, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Kreinberg et al. Kreinberg et al. discloses an adapter comprising a planar, top mounting surface (48), flanges (50 and 62, 54 and 64) depending from the mounting surface, and mounting legs extending from the flanges. The mounting legs (20, 22) each have a hook-like portion (26) extending substantially along the width of the mounting leg and the adapter is flexible to permit urging of the flanges inwardly toward one another. The mounting legs include an inwardly extending portion (36, 40) contiguous with a downwardly extending portion, wherein the hook-like portion is formed at an end of the downwardly extending portion. An opening (56) is formed in the mounting surface, which is the top, planar surface. The adapter being flexible (see the abstract) to permit urging of the flanges toward each other. There is at least one binding element (72) formed on the inwardly extending portion of at least one of the mounting legs cooperating with the hook-like portion.

Claims 73-75, 78, 82, 142 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 3,536,281 to Meehan et al. Meehan et al. discloses a unitary resilient adapter (12) with a hanger receiving portion (84 and 86). The adapter has opposed mounting legs (58 and 60) with feet (66 and 68) configured to engage a channel lip. There is an article support hanger 10 with a portion configured to be received by the hanger receiving portion of the adapter. The article support hanger is configured to engage the adapter with a snap action and lock into the hanger receiving portion. The article support hanger can also be stacked and has a provision (24, 34) whereby a second article support hanger could be connected to it. A swivel joint (88) connects the adapter and hanger and the support has a generally U-shaped configuration with support legs that could engage the adapter.

***Claim Rejections - 35 USC § 103***

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg in view of U.S. Patent 5,533,696 to Laughlin et al. Kreinberg does not disclose a binding element in the form of a tab formed in the inwardly extending portion that is defined by a pair of notches in the inwardly extending portion. Laughlin et al. provides a teaching for providing inwardly extending tabs (72) defined by a pair of notches (on each side of the tab) on the inner leg portion of an adapter to further secure an object in the receiving space. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have provided the tabs taught by Laughlin

et al., on the interior of the legs taught by Kreinberg, for the purpose of further securing an object in the adapter.

Claims 11, 12, 30, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg in view of U.S. Patent 6,452,095 B1 to Perrault. Kreinberg does not disclose a collar with threads formed therein. Perrault discloses a hanger (see figs. 9 and 10) for suspending cables from a threaded rod (54). The mounting surface (see fig. 10 and 11) includes a collar (57) with threads formed therein for suspending the hanger from a threaded rod (54). It would have been obvious to one of ordinary skill in the art at the time of the present invention to have utilized a threaded collar on the mounting surface taught by Kreinberg, as taught by Perrault, for the purpose of providing a secure connection for hanging the hanger from a threaded rod.

Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg. Kreinberg does not specifically disclose a curved mounting surface for mounting the hanger. However, the shape of the mounting surface is a matter of design preference that would have been obvious to one of ordinary skill in the art at the time of the present invention.

Claims 13 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kreinberg in view of Andre. Kreinberg does not disclose a plurality of downwardly, inwardly oriented tabs extending from a periphery of the opening. Andre provides a teaching of providing downwardly, inwardly oriented tabs around the periphery of an opening for supporting a cylindrical member. It would have been obvious to one of ordinary skill in the art at the time of the present invention to have provided

downwardly/inwardly oriented tabs around the periphery of the opening taught by Kreinberg, as taught by Andre, for the purpose of securing a cylindrical member (in this case the threaded rod) within the opening.

### ***Response to Arguments***

Applicant's arguments filed March 15, 2004 have been fully considered but they are not persuasive. In response to applicant's arguments, the recitation "For use with an anchor rail" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The Examiner also disagrees with Applicant's assertion that Kreinberg et al. lacks certain features as identified above in the body of the 102 rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Marsh whose telephone number is

Art Unit: 3632

(703) 305-0098. The examiner can normally be reached on Monday-Friday from 8:00AM to 4:30 PM. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2168. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3597.

*SM*  
Steven M. Marsh

June 14, 2004

LESLIE A. BRAUN  
SUPERVISORY PATENT EXAMINER

